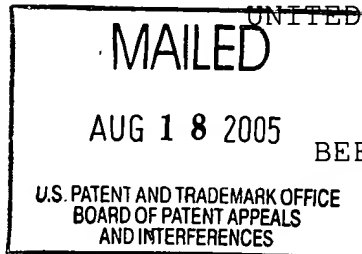


The opinion in support of the decision being entered today was not written for publication in a law journal and is not binding precedent of the Board.



UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte JUNJI MACHIDA and HIROSHI GOTO

Appeal No. 2005-1596  
Application No. 09/924,494

ON BRIEF

Before KIMLIN, WARREN and PAWLIKOWSKI, Administrative Patent Judges.

KIMLIN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1-5 and 21-23. Claims 6-20 have been withdrawn from consideration. Claim 23 is illustrative:

23. A developing device comprising:

a developer carrying member having a rubber hardness of 20 to 70 degrees, an elongation of 400 to 1200% and a volume electrical resistance of  $1 \times 10^4$  to  $1 \times 10^9 \Omega \cdot \text{cm}$  at its surface;

a storage portion for storing a toner to be supplied to the developer carrying member, the toner containing an organic aromatic solvent and a vinyl monomer in combined concentrations of not more than 500 ppm.

Appeal No. 2005-1596  
Application No. 09/924,494

The examiner relies upon the following references as evidence of obviousness:

Shimojo et al. (Shimojo)	5,436,701	Jul. 25, 1995
Kasuya et al. (Kasuya)	5,571,653	Nov. 5, 1996
Machida et al. (Machida)	5,875,379	Feb. 23, 1999

Appellants' claimed invention is directed to a developing device comprising a developer carrying member of the recited properties, a storage portion for developing toner, and a regulating member in contact with the developer carrying member which controls the amount of toner carried on the developer carrying member.

Appealed claims 1-5, 22 and 23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Machida in view of Kasuya. Claim 21 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over the stated combination of references further in view of Shimojo.

Appellants submit at page 4 of the Brief that "[c]laims 1-5 and 21-23 stand or fall together." Accordingly, all the appealed claims stand or fall together with claim 23, the broadest claim on appeal.

We have thoroughly reviewed each of appellants' arguments for patentability. However, we are in complete agreement with the examiner that the claimed subject matter would have been

Appeal No. 2005-1596  
Application No. 09/924,494

obvious to one of ordinary skill in the art within the meaning of § 103 in view of the applied prior art. Accordingly, we will sustain the examiner's rejections for the reasons set forth in the Answer, which we incorporate herein.

Appellants do not dispute the examiner's factual determination that Machida, like appellants, discloses a developing device comprising the presently claimed developer carrying member of the recited properties, a storage portion for toner, and a regulating member disposed in contacting relation with the surface of the developer carrying member. Hence, although Machida does not disclose the particular toner recited in the appealed claims, it cannot be gainsaid that the reference describes each of the structural components of the claimed device within the meaning of 35 U.S.C. § 102. It is well settled that a claim recitation regarding the material intended to be worked upon by a claimed device does not impose any structural limitations upon the claimed device which distinguishes it from a prior art device which describes the same structural limitations. Ex parte Masham, 2 USPQ2d 1647, 1648 (Bd. Pat. App. & Int. 1987); In re Rishoi, 197 F.2d 342, 345, 94 USPQ 71, 73 (CCPA 1952). See also In re Yanush, 477 F.2d 958, 958, 177 USPQ 705, 706 (CCPA 1973) and In re Finsterwalder, 436 F.2d 1028, 1032, 168 USPQ 530,

534 (CCPA 1971). Appellants have made no argument, let alone demonstrated, that the toner storage portion described by Machida is not capable of supplying the recited toner to the developer carrying member. Consequently, since anticipation is the epitome of obviousness, it follows that we find the claimed subject matter unpatentable over Machida under 35 U.S.C. § 103.

Furthermore, we fully concur with the examiner that it would have been obvious for one of ordinary skill in the art to use the claimed toner in the developing device of Machida. While Kasuya teaches that appellants' toner is especially efficient in heat fixation of the image, and Machida does not mention heat fixing, we are satisfied that it would have been obvious for one of ordinary skill in the art to utilize the notoriously well-known heat fixing in the process of Machida. Appellants have apprised us of no sound reason why one of ordinary skill in the art would have found the toner of Kasuya, and that presently claimed, to be unsuitable for the developing device of Machida.

While appellants refer to Comparative Examples 2-1 and 2-2 of the present specification, which represent concentrations of solvent and monomer greater than the claimed upper limit of 500 ppm, appellants have not established that the results are

Appeal No. 2005-1596  
Application No. 09/924,494

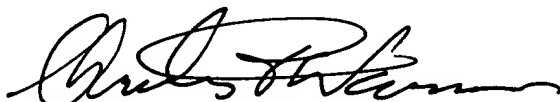
truly unexpected in light of Kasuya's preference for a concentration of not more than 300 ppm.

In conclusion, based on the foregoing and the reasons well-stated by the examiner, the examiner's decision rejecting the appealed claims is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv) (effective Sep. 13, 2004; 69 Fed. Reg. 49960 (Aug. 12, 2004); 1286 Off. Gaz. Pat. Office 21 (Sep. 7, 2004)).

AFFIRMED

  
EDWARD C. KIMLIN )  
Administrative Patent Judge )

  
CHARLES F. WARREN )  
Administrative Patent Judge )

BOARD OF PATENT  
APPEALS AND  
INTERFERENCES

  
BEVERLY PAWLIKOWSKI )  
Administrative Patent Judge )

ECK:clm

Appeal No. 2005-1596  
Application No. 09/924,494

Morris & Foerster LLP  
1650 Tysons Blvd.  
Suite 300  
McLean, VA 22102